

REMARKS/ARGUMENTS

Claims 14 and 23 have been revised to feature the decreased HOXB13 expression levels and a lack of cancer recurrence, or good survival outcome, with omission of IL17BR expression and a ratio of HOXB13 to IL17BR expression levels. The dependent claims have been revised or canceled to be consistent with the revisions to Claims 14 and 23.

Support for the revisions is found in the specification and figures of U.S. Patent 7,504,214, to which the instant application claims benefit of priority. Applicants direct the Office's attention in particular to Examples 3 and 4 as well as Figures 3, 5, and 6 in the issued patent.

For example, Tables 4 and 5 in Example 3 include identification of the 'mean' expression levels of HoxB13 sequences in "sections" and "LCM" samples from tamoxifen responders and non-responders. The expression level data from these "sections" and "LCM" samples for each of HoxB13 were scaled and plotted as values in Figure 3, which presents the value for each of the samples from both tamoxifen responders and non-responders. Figure 5 illustrates how responders have a lower risk of cancer recurrence, while Figure 6 presents similar data from FFPE breast cancer samples. Applicants point out that Tables 4 and 5 of the issued patent are identical to Tables 2 and 3 of the instant application.

The revisions are made for business reasons rather than any alleged issue of patentability, and Applicants expressly reserve the right to re-present, in a continuing application, claims directed to subject matter no longer encompassed by the revised claims. No new matter has been introduced, and entry of the above claims is respectfully requested.

Priority

With regard to the allegations regarding support from prior U.S. applications 60/504,087 and 10/727,100, Applicants respectfully point out that they are not applicable to the revised claims and so respectfully request reconsideration as may be deemed appropriate by the Office. Until such reconsideration occurs, Applicants acknowledge the current indication that

for prior art purposes, the February 6, 2004 filing date of the instant application has been used by the Office. Applicants expressly reserve their right to withdraw the claim of priority to one or both of the above-listed applications.

Objections to the Claims

Claim 73 was objected to for having an incorrect status identifier. This has been corrected in the currently amended claims, and this objection is believed to be no longer applicable.

Alleged Rejection Under 35 U.S.C. § 1.112, first paragraph

Claims 14, 16, 18-23, 25, 27-31, 52-55, 62, 63, 71, and 73 were rejected under the above-listed statute as allegedly containing “new matter.” Applicants have reviewed the statement of the rejection and respectfully submit that no *prima facie* case is present with respect to the revised claims as presented above.

Because the basis of this rejection appears to center on a feature no longer present in the revised claims, Applicants respectfully request reconsideration and withdrawal of this rejection.

Alleged Double Patenting Rejections

Claims 14, 16, 18, 19, 21-23, 25, 27, 28, 30, 31, 52-55, 62, and 63 were rejected on the ground of non-statutory obviousness-type double patenting as allegedly unpatentable over Claims 1-43 of U.S. Patent 7,504,214 B2. Applicants have reviewed the statement of the rejection and respectfully submit that no case is present with respect to the revised claims as presented above.

The revised claims no longer feature the use of expression levels from HOXB13 and IL17BR as featured in the claims of the patent. Accordingly, the instant claims are distinct and non-obvious over the patented claims. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 20 and 29 were rejected on the ground of non-statutory obviousness-type double patenting as allegedly unpatentable over Claims 1-43 of U.S. Patent 7,504,214 B2 and Gibson et al. Applicants have reviewed the statement of the rejection and respectfully submit that no case is present with respect to the revised claims as presented above.

The revised claims no longer feature the use of expression levels from HOXB13 and IL17BR as featured in the claims of the patent. Accordingly, the instant claims are distinct and non-obvious over the patented claims. Applicants respectfully request reconsideration and withdrawal of this rejection.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 425-681-1833.

Respectfully submitted,

/kawai lau/
Kawai Lau, Ph.D.
Reg. No. 44,461

PATENTIQUE PLLC
PO Box 50368
Bellevue, Washington 98015
Tel: 425-228-0818
Fax: 425-228-8192